

REMARKS

Claims presented for prosecution in this Application are claims 1 and 5-13, claims 2-4 being canceled and claims 12-13 being added by the present Response. Claims 1-11 have been rejected over cited prior art. In view of Applicants' remarks below, Applicants respectfully submit that claims 1 and 5-13 are in condition for allowance. Accordingly, Applicants respectfully request that the present Response be considered and entered, the rejections to the claims be withdrawn, and that the case now be passed to issue.

The Objection to the Disclosure

The Examiner has objected to the disclosure on formalistic grounds. In response, Applicants have amended the specification in accordance with the Examiner's suggestion.

In light of the above, Applicants respectfully request withdrawal of the outstanding objection to the disclosure.

The 35 USC 112 Second Paragraph Rejection of Claims 1-11

The Examiner has rejected claims 1-11 as being indefinite. In response, Applicants have amended claim 1 in order to address the Examiner's concern in this regard.

In light of the amendment to claim 1, Applicants respectfully request that the outstanding 35 USC 112 second paragraph rejection of claims 1-11 be withdrawn.

The 35 USC 102(b) Rejection of Claims 1, 2 and 7 over Nagashima

The Examiner has rejected claims 1, 2 and 7 as being anticipated by Nagashima ('970). In response, Applicants respectfully assert that Nagashima does not disclose, at least, each and every aspect of newly amended independent claim 1.

Independent claim 1 now explicitly recites, *inter alia*,

"A hand-held machine tool (100) comprising:

a combustion engine drive (116);

a generator (102) for supplying voltage to an internal electrical consumer, said generator (102) having a connection for attachments (104) for an external electrical consumer;

wherein said connection for attachments is a plug socket" (emphasis added).

The present invention is directed towards providing a measure of electrical flexibility and efficiency not heretofore enjoyed by hand-held machine tools. As discussed on pages 1-3 of the specification, hand-held machine tools are known in which an internal generator powers an internally located electrical component, such as a heating element located in the grip portion of saws and disk grinders. Nagashima is merely one example of this type of known machine tool.

What is not known, however, is to provide *an additional level* of operability to such hand-held machine tools such that they also support a plug socket for supplying power to a wide variety of external electrical accessories *in addition to* any internally powered components. The present invention addresses this need in the art, while Nagashima is completely silent as to the possibility of powering an external electrical accessory via a plug socket located thereon.

That is, in stark contrast with the present invention, Nagashima merely discloses the known arrangement whereby an internally located printed heater (10) is powered by the chain saw's generator. Thus, with specific respect to claim 1, Nagashima is devoid of, at least, a generator having a plug socket for connecting to an external consumer of electricity.

As Nagashima does not disclose or suggest each and every aspect of independent claim 1, Applicants respectfully request withdrawal of the outstanding 35 USC 102(b) rejection of claims 1, 2 and 7 on this basis alone.

Applicants also respectfully request that should the Examiner maintain this rejection, that the Examiner specifically note Nagashima's internal and external consumers that are powered by Nagashima's generator, as well as Nagashima's plug socket for connecting to the external consumer.

Applicants earnestly believe that independent claim 1, at least, clearly defines over Nagashima, however, should the Examiner believe that there remains any outstanding issues, Applicants respectfully request that the Examiner contact Applicants' Representative so as to expedite resolution of these outstanding issues without the necessity of another Office Action.

The 35 USC 103(a) Rejection of Claims 3-6 and 8-11 over Nagashima in view of Leininger

The Examiner has rejected claims 3-6 and 8-11 as being obvious over Nagashima in view of Leininger. Applicants respectfully assert that neither Nagashima nor Leininger, either alone or in combination, discloses each and every aspect of newly amended independent claim 1.

As discussed previously, Nagashima is completely devoid of any teaching or suggestion that a plug socket may be provided on Nagashima's chain saw to facilitate the powering of an external consumer of electricity, as explicitly recited in independent claim 1. Applicants respectfully contend that Leininger fails to address this shortcoming of Nagashima.

Leininger's teaching extends only to a pneumatic tool having a dedicated electrical connection for a lamp. More specifically, neither Leininger's drawings nor Leininger's specification even suggests the possibility that a plug socket (or the like) may be provided to Leininger's housing so as to power a wide variety of external electrical accessories. Thus, Leininger's teaching is limited to the very narrow application of a tool capable of powering a dedicated electrical device; Leininger does not, therefore, reflect any appreciation, or provide any solution, for the desire to provide a plug socket for the powering of a wide variety of electrical accessories, as is addressed by the present invention.

Applicants therefore respectfully assert that any jump from Leininger's dedicated (non-plug socket) lamp connection, to Applicants' invention as recited in claim 1, is only possible with the benefit of impermissible hindsight.

With particular respect to the outstanding Office Action in which the Examiner has taken Official Notice that, "it is well known in the art to use plug, and plug socket with cover to connect an electrical component to the electrical generator", Applicants respectfully request that the Examiner *provide a prior art reference*, in accordance with MPEP § 2144.03, in which it is shown to use a plug socket on a hand-held machine tool for powering an external consumer, as is recited in claim 1, and in support of the Examiner's Official Notice.

Still further, Applicants respectfully suggest that Applicants' invention dwells not in merely providing a plug (or plug socket) by which to connect an electrical component to an electrical generator, but providing these known electrical

components on such a machine, and in such a orientation, and to such an effect, as is recited in claim 1. That is, Applicants refer to MPEP § 2141.02 in which it states that “the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious” (emphasis in the original).

In the present case, Applicants respectfully assert that neither Nagashima nor Leininger teach or even suggest the ability of a hand-held machine tool to have *both* a generator-powered internal electrical consumer *as well as* a plug socket for supplying power to external electrical consumers. Therefore, the issue at present goes beyond the Official Notice taken in the outstanding Office Action, and must be considered in light of MPEP § 2141.02’s admonition to consider the claim, and therefore the invention, as a whole.

Applicants therefore respectfully assert that Leininger simply does not disclose, at least, Nagashima’s missing ‘plug socket’ for connecting external consumers. Applicants therefore request withdrawal of the outstanding rejection on this basis alone.

Moreover, Applicants respectfully submit that there exists no teaching or suggestion within either Nagashima or Leininger that would have motivated one of ordinary skill in the art to combine them in the manner proposed in the outstanding Office Action. As mentioned previously, Nagashima does not teach or even suggest providing internal-generator power to any external electrical device *at all*, therefore there exists no motivation to combine Leininger’s particular configuration with Nagashima’s apparatus. Applicants therefore request withdrawal of the outstanding rejection on this basis alone.

Still further, and of significance with respect to Applicants invention when taken as a whole, neither cited reference teaches or suggests powering *both* internal and external electrical consumers via an internal generator of a hand-held machine tool, as is explicitly recited in claim 1, let alone teaching or suggesting the use of a plug socket by which to accommodate a wide variety of electrical consumers. Whatever Nagashima and Leininger can be said to disclose, they are quite silent as to any desire or ability to become adaptable to a multitude of external electrical consumers. Again, Applicants respectfully request withdrawal of the outstanding rejection on this basis alone.

Applicants earnestly believe that independent claim 1, at least, clearly defines over both Nagashima and Leininger, however, should the Examiner believe that there remains any outstanding issues, Applicants respectfully request that the Examiner contact Applicants' Representative so as to expedite resolution of these outstanding issues.

New Claims 12 and 13

Applicants have newly proposed claims 12 and 13 in order to more fully recite Applicants scope of protection. Both claims 12 and 13 recite the presence of a plug socket accessible through the housing of a chain saw for powering an external electrical accessory. Moreover, claim 12 further recites the dual powering of an internal electrical device in the context of chain saws.

Applicants refer to the arguments and points raised above and respectfully assert that none of the prior art references teach or suggest, at least, equipping a *chain saw with a plug socket* for supplying power to a wide variety of *external electrical accessories.*

Indeed, as also noted above, none of the prior art references even suggests the desire or preference to equip a chain saw so as to be able to power a disparate collection of electrical accessories.

Applicants therefore respectfully request allowance of claims 12 and 13 in due course.

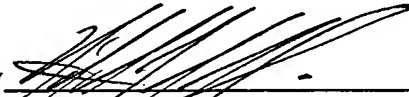
CONCLUSION

In view of the remarks above, it is respectfully submitted that claims 1 and 5-13 are allowable, and an early action to that effect is earnestly solicited.

The Examiner is invited to contact the undersigned at the number below to expedite resolution of any issues that the Examiner may consider to remain unresolved. In particular, should a Notice of Allowance not be forthcoming, the Examiner is requested to phone the undersigned for a telephonic interview, an Examiner's amendment, or the like, while the outstanding issues are fresh in the mind of the Examiner.

Please charge the fee for the attached One-Month Extension to our Deposit Account No. 13-0235. It is believed that no additional fees or deficiencies in fees are owed. However, authorization is hereby given to charge our Deposit Account No. 13-0235 in the event any additional fees are owed.

Respectfully submitted,

By 
Nicholas J. Tuccillo
Registration No. 44,322
Attorney for Applicants

McCORMICK, PAULDING & HUBER LLP
CityPlace II, 185 Asylum Street
Hartford, CT 06103-4102
Tel.: (860) 549-5290
Fax: (413) 733-4543